

## **REMARKS/ARGUMENTS**

Based on the *Final Office Action* of 17 November 2005 and the subsequent appeal (see the *Appeal Brief* of 31 August 2006), Claims 41-42 and 44-53 were pending in the *Application*, and all were rejected.

Based on the *Decision of Appeal* of 06 November 2007, the Board sustained the rejection to Claims 41-42 and 44-45, and entered a new ground of rejection under 37 C.F.R. § 41.50(b) for Claims 46-53.

By the present *Response and Amendment*, Applicant respectfully elects to reopen prosecution before the Examiner by submitting the appropriate amendment. Accordingly, in this *Response and Amendment*, Applicant cancels Claims 1-45, currently amends Claims 46, 49-50, and 53, and makes no changes to the previously presented Claims 47-48 and 51-52.

No new matter is introduced by the present *Response and Amendment*. It is respectfully submitted that the present *Application* is in condition for allowance.

### **1. New Ground of Rejection**

In the *Decision*, the Board entered a new ground of rejection, under 37 C.F.R. § 41.50(b), for Claims 46-53. Specifically, Claims 46-53 are rejected under 35 U.S.C. § 103(a) (hereinafter “§ 103”) as being unpatentable over the May 1998 SMART Board Product Manual (hereinafter referred to as the “cited reference” or the “*Manual*”). *See Decision, p. 11.*

### **2. Board’s Reasoning For New Ground of Rejection**

According to the Board, the *Manual* discloses all of the claimed subject matter except for “projecting an image onto the whiteboard to occur *directly after* initiating the calibration process (i.e., Step 1 [of the *Manual*])” (emphasis in original) of independent Claim 46. Further, the Board opines that the *Manual* discloses all of the claimed subject matter except for “projecting a calibration image onto the whiteboard to be *directly preceded by* signaling the whiteboard system to project the calibration image (i.e., Step 1)” (emphasis in original) of independent Claim 50. *Id.*

The Board asserts that **eliminating** three of the required six steps for orienting a whiteboard, as disclosed in the *Manual*, would be obvious to one skilled in the art. Specifically, “a *single, default orientation level* in lieu of multiple orientation levels would have been a modification well within the level of ordinary skill in the art.” (emphasis in original). The Board

further found that providing a single, default orientation level would automatically launch the calibration image using a predefined orientation level directly after Step 1, and thus would bypass Steps 2-4. Thus, a user would not need to preview the orientation levels and select a desired orientation level (see Steps 2-4) each time the whiteboard is oriented. In essence, this “default” feature would bypass Steps 2-4 and therefore display the calibration image (Step 5) directly after Step 1. *Id. at 11-12.*

### **3. The Amendments To The Pending Claims Are Patentably Distinct From the Cited Reference**

Applicant respectfully submits that the new limitations presented in the amendments to Claims 46, 49-50, and 53 overcome the cited reference.

In addition, as MPEP § 1213.01 alludes, Applicant may amend the Claims to conform with statements of how a Claim on appeal may be amended to overcome a specific rejection. Even though the Board does not provide an “explicit statement,” Applicant respectfully submits that on pages 7 and 9 of the *Decision*, the Board suggests how to amend the Claim to overcome the *Manual*.

Specifically, both footnote 4 of the *Decision* (see p. 7 of *Decision*) and page 6 of the *Record of Oral Hearing* suggest the changing the transition of the calibration process in the Jepson Claim from “including” to “consisting of.” Applicant amends Claim 46 accordingly.

Also, footnote 7 of the *Decision* (see p. 9 of *Decision*) suggests clarifying that the remote control recited in Claims 49 and 53 refer to a “handheld” remote control. Applicant amends Claims 49 and 53 to correspond with this suggestion.

Accordingly, Applicant respectfully submits that the amended Claims, and those Claims that ultimately depend therefrom, conform with the suggestions of the Board, and further render the Claims patentably distinct from the cited reference.

### **4. Response To Board’s New Ground of Rejection**

Applicant respectfully submits that: (1) eliminating the steps of the prior art orientation method fails to yield the present invention; (2) eliminating the steps of *Manual’s* orientation method destroys the intent of the reference; and (3) the Board uses impermissible hindsight at arriving at the new ground of rejection.

**A. Eliminating The Steps of The *Manual* Fails To Yield The Claimed Invention**

To arrive at the claimed invention for Claims 46 and 51, and ultimately their dependencies, the Board asserts that simply removing Steps 2-4 of the *Manual* would not only be obvious to one skilled in the art, but would also yield the present invention.

The *Manual* identifies five sequential steps to “orient” the board to a computer. Step 1 includes: “Select Orient Board from the Board menu, or Press the Orient Board button ..., or click or press twice on the SMART Board icon in the System Tray, or Press the Pen Tray buttons simultaneously.” Step 2 includes: “Preview the three orientation levels ... by clicking on the circle next to each heading.” Step 3 includes: “Once you have determined the orientation level you prefer, select it by clicking the appropriate circle.” Step 4 includes: “Click the Next button.” Step 5 includes: “Follow the on-screen instructions, pressing your finger squarely on the yellow center of each red cross, in the order specified by the large white arrow. To begin the orientation, press on the cross highlighted in red at the upper-left corner of the screen. You will hear a beep and the next cross in the series will be highlighted in red.” *Manual Pgs. 27-28.*

Fundamentally, Steps 2-4 of the *Manual* are three essential steps for orientating the whiteboard to a computer. If these steps are removed, the board can not be oriented to the computer. Moreover, Step 4 of the prior art’s orientation method causes the projection of a calibration image to occur. By eliminating Step 4, as the Board asserts, the image would not be projected. Consequently, Step 5 would never occur.

By eliminating Step 4 of the *Manual*, the prior art reference includes solely Steps 1 and 5. Steps 1 and 5 do not yield the claimed invention. If Step 4 were to be removed from the six step process of the *Manual*, the reference could not perform the steps of the claimed invention. And with Step 4 included in the method, the claimed invention is patentably distinct.

Applicant respectfully submits that eliminating steps of the cited reference process fails to yield the claimed invention.

**B. Eliminating The Steps Of The *Manual* Destroys The Intent Of The Reference**

The intent of the cited reference is to describe the operation and use of the SMART Board.

Applicant respectfully submits that the Board, in arriving at this specific construction, has destroyed the intent of the reference. In this regard, courts have held that “[i]f the proposed

modification would render the prior art invention being modified unsatisfactorily for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon* 733 F. 2d 900, 221 USPQ 1125 (Fed. Cir. 1984). The courts have also held that “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious.” *In re Ratti* 270 F. 2d 810, 123 USPQ 349 (CCPA 1959).

By eliminating steps of the orientation process in the *Manual*, the intent of the reference is destroyed. The *Manual* discloses a six-step process for orientating a whiteboard to a computer. By eliminating necessary steps of this process, the orientation process fails.

Applicant respectfully submits that eliminating steps of the *Manual*’s orientation process destroys the intent of the prior art reference.

### **C. Impermissible Hindsight Was Used To Arrive At The New Ground Of Rejection**

Applicant respectfully submits that removing three of the six essential steps (*i.e.*, Steps 2-4) of the *Manual* is using an improper standard in arriving at the rejection under § 103, based on improper hindsight, which fails to consider the totality of Applicant’s invention and to the totality of the cited reference. More specifically, the Board has used Applicant’s disclosure to select portions of the cited reference to allegedly arrive at Applicant’s invention. In doing so, the Board has failed to consider the teachings of the reference or Applicant’s invention as a whole in contravention of § 103, including the disclosures of the reference which teach away from the claimed invention.

In applying § 103, the U.S. Court of Appeals for the Federal Circuit has consistently held that one must consider both the invention and the prior art “as a whole”, not from improper hindsight gained from consideration of the claimed invention. See, *Interconnect Planning Corp. v. Feil*, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985) and cases cited therein. According to the *Interconnect* court

[n]ot only must the claimed invention as a whole be evaluated, but so also must the references as a whole, so that their teachings are applied in the context of their significance to a technician at the time - a technician without our knowledge of the solution.

*Id.* Also critical to this Section 103 analysis is that understanding of “particular results” achieved by the invention. *Id.*

The *Manual* discloses the exact method of orientating a whiteboard to a computer that the claimed invention desired to improve upon. One purpose of the claimed invention was to improve and ease the process of calibration. Initiating the calibration process distant the computer, making initiation a one-step process, and projecting a calibration image onto the whiteboard directly preceded by signaling the whiteboard to project the image were contemplated by the inventors to overcome the challenges of prior art systems.

Without the use of hindsight, one skilled in the art would not have used the cited reference to arrive at the claimed invention.

In arriving at the new ground of rejection, Applicant respectfully submits that the Board uses impermissible hindsight to arrive at the claimed invention. Applicant further respectfully submits that without the use of hindsight the claimed invention is taught, suggested, or disclosed in the *Manual*.

## **5. Fees**

This *Response and Amendment* is being filed within two months of the *Decision* as required under 37 C.F.R. § 41.50(b). The original due date of the present *Response and Amendment* was 06 January 2008, which fell on a Sunday. This *Response and Amendment* is being filed on the next business day, that is, Monday, 07 January 2008. (*see* 37 C.F.R. § 1.7). A fee is not believed due for the timing of this *Response and Amendment*.

In addition, no additional Claims fees are believed due, as the total number of Claims, and independent Claims, is less than that paid upon original filing and prosecution.

Nonetheless, authorization to charge deposit account No. 20-1507 is given herein for all fees deemed due.

## **CONCLUSION**

By the present *Response and Amendment*, the *Application* has been in placed in full condition for allowance. Accordingly, Applicants respectfully request early and favorable action. Should the Examiner have any further questions or reservations, the Examiner is invited to telephone the undersigned Attorney at 404.885.3340.

Respectfully submitted,

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